

Remarks

The various parts of the Office Action (and other matters, if any) are discussed below under appropriate headings.

Claim Objections

Claims 1 and 5 were objected to due to typographical errors and/or informalities and claims 4, 9, 11 and 12 were objected to for lack of antecedent basis. The claims have been corrected. Accordingly, the objections should be withdrawn.

Claim Rejections - 35 USC § 112

Claims 1-6 and 9-13 were rejected for want of an enabling disclosure. In light of the amendments to the claims, it is respectfully submitted that this rejection is moot and the claims presented above are enabled. Therefore, the rejection should be withdrawn.

Claim Rejections - 35 USC § 103

Claim 1, as amended, recites a method of detecting the shape of a patient body part to be treated, which includes, *inter alia*, producing a camera image of the patient body part and mapping a sufficient number of outlines of the patient body part to establish a three-dimensional shape of the patient body part.

Cosman, taken alone or in combination with any of the cited references, fails to disclose or fairly suggest the claimed invention. As noted by the Examiner, Cosman fails to disclose establishing a three-dimensional shape of a patient body part by mapping an outline of the patient body part in multiple focusing distances. While the Examiner relies on Nayar to supplement the disclosure of Cosman, it is respectfully submitted that this rejection is improper because there is no motivation to combine Cosman and Nayar. Further, there is no motivation to modify Nayar to arrive at the claimed invention.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination or modification and the reasonable expectation of success must both be found in the prior art, and not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also, *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

There is no motivation to combine Cosman and Nayar. On page 6 of the office action, the Examiner contends that "Cosman and Nayar are both concerned with image processing systems for detecting the three dimensional shape of an object." This is not enough to establish a prima facie case of obviousness. Nayar is concerned with extracting shapes of surfaces having "visible roughness." Nayar makes no mention of any medical application, let alone, mapping a three-dimensional shape of a patient body part using multiple focusing distances. "Image processing" is such a broad field with so many completely different applications that this term does not connect Cosman and Nayar in a way sufficient to support a prima facie case of obviousness.

For at least these reasons, it is respectfully submitted that claim 1 and claims 2-6, 9-13 and 18 dependent therefrom distinguish patentably over the references of record. Accordingly, the rejection should be withdrawn.


For at least the reasons articulated above with respect to claim 1, it is respectfully submitted that new claim 19 distinguishes patentably over the references of record.

Conclusion

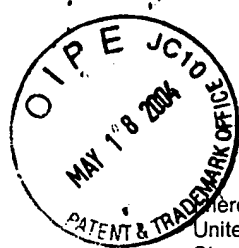
In view of the foregoing, request is made for timely issuance of a notice of allowance.

Respectfully submitted,

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